

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/785,237

REMARKS

Claims 1-11 and 26-32 are all the claims pending in the application. By this Amendment, Applicant cancels the non-elected claims 12-25, without prejudice or disclaimer. Applicant reserves the right to file a divisional application directed to the non-elected invention. In addition, Applicant adds claims 26-32. Claims 26-32 are clearly supported throughout the specification, *e.g.*, pages 8 and 9 of the specification. Finally, Applicant amends claims 1 and 8 to further clarify the invention.

I. Preliminary Matters

Applicant thanks the Examiner for acknowledging the claim to foreign priority under 35 U.S.C. §119. The Examiner, however, failed to indicate the receipt of the certified copy of the priority document filed on July 19, 2001. Therefore, Applicant respectfully requests the Examiner, in the next Office Action, to check the appropriate box (12/a)/1.) on the Form PTO-326 indicating that the certified copy of the priority document has been received.

The Examiner has failed to indicate the receipt or consideration of the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on February 20, 2001. Therefore, Applicant respectfully requests the Examiner to acknowledge receipt of the Information Disclosure Statement filed on February 20, 2001 and initial and return a copy of the form PTO-1449. For Examiner's convenience, a copy of the form PTO-1449 as filed on February 20, 2001, is enclosed.

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II. Summary of the Office Action

The Examiner objected to the drawings and the specification for minor informalities. In addition, the Examiner rejected claims 1-11 under 35 U.S.C. § 102(b).

III. Specification Objection

The Examiner objected to the specification for improper use of trademarks (Microsoft ExchangeTM) in the specification (see page 2 of the Office Action). Applicant herein amends the specification to properly refer to the trademarks. In view of these amendments to the specification, Applicant respectfully requests the Examiner to now withdraw this objection.

IV. Drawings Objections

The Examiner objected to the drawings because the Figures do not depict reference numeral 12 discussed in the specification (see page 2 of the Office Action). Applicant herein amends the specification to delete the reference numeral 12. To conform the specification to the Figures, the specification now refers to the reference fields 19a or 19b.

In addition, the Examiner objected to the drawings because numeric reference “20” depicted in Figure 1 is not described in the specification (see page 2 of the Office Action). To remedy this minor informality, Applicant amends the specification to describe the numeric reference 20.

In view of these amendments to the specification, Applicant respectfully requests the Examiner to withdraw these objections to the drawings. Since no changes are being made to the drawings, no submission of corrected drawings is believed to be necessary in response to the present Office Action.

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V. Prior Art Rejections

Claims 1-11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,715,393 to Naugle (hereinafter “Naugle”). Applicant respectfully traverses this rejection in view of the following comments.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Of the rejected claims, only claims 1, 5, and 8 are independent. To begin, independent claim 1, among a number of unique features, recites: “wherein the message is an e-mail message generated in response to an operation of the automation system.” The Examiner alleges that claim 1 is directed to a system operable to generate a message related to a control unit of an automation system and is anticipated by Naugle. In particular, the Examiner alleges that Naugle’s status message is equivalent to the message as set forth in claim 1. Applicant respectfully disagrees. Applicant has carefully studied Naugle’s discussion of the message, which lacks generating a status message in response to the operation of the automation system.

For example, in the illustrative, non-limiting embodiment, it is disclosed that the control unit monitors the operations of the automation system. When a predetermined threshold that relates to the operation of the automation system is reached or when a fault in the operation of the automation system occurs, the control unit generates an e-mail message and transmits it to the receiving device, which responds to this message. That is, in the exemplary, non-limiting

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embodiment, the e-mail message is generated in response to the operation of the automation system.

Naugle, on the other hand, relates to a remote monitoring of a system process. In particular, Naugle discloses that a computer system may control any variety of tasks, and that the problems with these computer system need to be reported internally without the human intervention (col. 1, lines 19 to 26). Naugle further discloses that in the prior art techniques, monitoring operation of a remote computer requires the remote monitoring system to log onto the target remote computer and record any error messages or sound alarm to alert the operator of any problems (col. 1, lines 35 to 42). Naugle further discloses that this technique is very complex, requires custom design, and provides additional security risks due to the remote logon (col. 1, lines 42 to 58).

Accordingly, Naugle proposes a method for remote system monitoring which has two computer systems which operate independently but which are linked in such a way that they can exchange electronic mail with each other. An electronic mail message is sent between the computer systems which activates a monitoring program on the remote computer system. The monitoring program generates a status report which is returned to the monitoring computer by means of a second electronic mail message (col. 1, line 60 to col. 2, line 4).

Specifically, Naugle discloses the following process: a) the monitor computer queries the target computer to check if the target computer is in operation (alive), b) the target computer responds that it is operational (otherwise, no status information can be obtained), c) then, the monitor computer sends a status request to the target computer, and d) in response to this status

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request, the target computer sends a status message as shown in col. 4, line 39 to col. 5, line 18 (Fig. 2; col. 2, lines 48 to 66, col. 4, lines 9 to 37).

If the Examiner maintains that “the status message of cols. 4-5” is equivalent to the e-mail message as set forth in claim 1 (see page 4 of the Office Action), then Applicant respectfully submits that Naugle does not teach or suggest an automated reply. Instead, Naugle teaches that the information from the status message is logged into a file. If no urgent error messages are noted then no further action is performed. If required, however, the status is evaluated and the operator is notified to take corrective action. Typically, the notification process includes activating a call to a paging service which delivers a message to a pager held by the operator (col. 5, lines 42 to 53). In other words, Naugle fails to teach or suggest the monitoring device automatically responding to the message.

Moreover, in Naugle, the status message is generated in response to the request received from the monitoring unit. In fact, the query sequence between the monitor computer and a particular target computer typically occurs at about 15 minute intervals (col. 2, lines 48 to 52). That is, the status message is sent in response to receiving a request from the monitoring device and not in response to the operation of the automation system. Furthermore, the query process in Naugle is started at a predetermined time and not in response to the operation of the automation system.

Therefore, the recitation “wherein the message is an e-mail message generated in response to an operation of the automation system,” as set forth in claim 1 is not disclosed by Naugle, which lacks generating the status message in response to the operation of the automation

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system. For at least this exemplary reason, Applicant respectfully submits that claim 1 is patentably distinguishable from Naugle. Therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 1. Claims 2-4 are patentable at least by virtue of their dependency.

Claim 5, among a number of unique features, recites: “a transmitting device operable to generate and transmit an alarm or fault message of the automation system.” The Examiner appears to equate this alarm or fault message of the automation system with either the alarm sounded in the conventional techniques disclosed in Naugle or with the status message as taught by Naugle (see page 5 of the Office Action). Applicant respectfully submits that these grounds of rejection are technically inaccurate for at least the following reasons.

Naugle discloses that in the prior art techniques, monitoring operation of a remote computer requires the remote monitoring system to log onto the target remote computer and record any error messages or sound alarm to alert the operator of any problems (col. 1, lines 35 to 42). That is, in the prior art techniques, no messages are sent to the remote monitoring system. Instead, the remote monitoring system logs onto the target computer and sounds an alarm when a problem is detected. In view of the number of problems with these techniques, Naugle discloses a system of sending messages from the remote monitoring device to the target computer. In particular, Naugle teaches in response to a request for a status update, the target computer transmits a status message. This status message is not an alarm but a report of the conditions at the target computer. In Naugle, the conditions reported are the conditions of the target computer and not some other system, *e.g.*, the automation system.

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Since Naugle only teaches having a status message and fails to teach or suggest the status message being an alarm or a fault message of the automation system, the rejection is improper as it lacks “sufficient specificity” required under 102. “[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP § 2131.

Therefore, “a transmitting device operable to generate and transmit an alarm or fault message of the automation system,” as set forth in claim 5, is not disclosed by Naugle, which lacks transmitting an alarm or a fault message of the automation system. Instead, in Naugle, the target computer transmits a status message of its own conditions. For at least these exemplary reasons, claim 5 is patentably distinguishable from Naugle. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 5 and its dependent claims 6, 7, 10, and 11.

Claim 8 recites features similar to the features argued above with respect to claim 1. Accordingly, arguments presented with respect to claim 1 apply by analogy here. For at least analogous reasons, claim 8 is patentably distinguishable from Naugle. Applicant respectfully requests the Examiner to withdraw this rejection of claim 8 and its dependent claim 9.

VI. New Claims

In order to provide more varied protection, Applicant adds claims 26-32. Claims 26-32 are patentable at least by virtue of their dependency on claim 1.

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VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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